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EXAMINER

PATEL, MANGLESH M

ART UNIT PAPER NUMBER

2178

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,891

Applicant(s)

HULL ET AL.

Examiner

Manglesh M. Patel

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-5/1-3/1-2 pg.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: IDS filed on June 5, 2002, March 25, 2005 and June 13, 2005 to the application filed on November 19, 2001.
2. Claims 1-28 are pending. Claims 1, 6, 11, 13, 18, 23 and 26 are independent claims.

Drawings

3. The examiner has accepted the Drawings files on February 20, 2002.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-7, 10, 13, 16-19, 22-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry (U.S. Pub 2002/0135808) in view of Wiernik (U.S. Pub 2001/0005203).

Regarding Independent claim 1, Parry teaches *printing the portions of the multimedia information that satisfy the selection criterion on a paper medium to generate the paper document comprising a set of one or more printed pages* (paragraph 7, wherein a method and apparatus are provided for printing digital video. The frames selected by the user are

printed. However Parry fails to explicitly teach a selection criterion used to determining the portions of multimedia to print); Wiernik explicitly teaches *receiving input identifying a selection criterion* (paragraph 19, wherein at least one selection criterion is used to create a derived multimedia application); *Analyzing the multimedia information stored by the plurality of multimedia documents to identify portions of multimedia information that satisfy the selected criterion, the portions of multimedia information including at least a first portion extracted from a first multimedia document from the plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents* (paragraph 20 and 21, wherein each of the screens conform to the selection criterion and additional multi-media screens are created inheriting characteristics from the existing screens. Therefore the first and second documents information must satisfy the selection criterion). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a criterion for determining portions of multimedia to be printed. The motivation for doing so would have been to prevent taking every possible path through the application, saving time. Therefore it would have been obvious to combine the teachings of Wiernik with Parry for the benefits of allowing the generation of paper-based multimedia information using a selection criterion to prevent the printing of undesired or similar portions of multimedia.

Regarding Dependent claim 4, Parry teaches *receiving information identifying a topic of interest* (paragraph 7, wherein a user may select to print certain frames of a digital

video or a certain time frame within the digital video. In addition the user can select the number of frames to skip between each printed frame of the digital video. Therefore frames that interest the user are selected).

Regarding Dependent claim 5, Parry teaches *printing the printable representation on the paper medium to generate the paper document* (paragraph 30, wherein video frames are printed once the user specifies the time or number of frames to print, therefore it is inherent that a paper medium with multimedia information is generated). *Generating a printable representation for the portions of the multimedia information that satisfy the selection criterion* (paragraph 7, wherein a method and apparatus are provided for printing digital video. The frames selected by the user are printed. However Parry fails to explicitly teach a selection criterion used to determining the portions of multimedia to print); Wiernik teaches that each of the screens conform to the selection criterion and additional multi-media screens are created inheriting characteristics from the existing screens (paragraph 20 and 21). Therefore the first and second documents information must satisfy the selection criterion. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a criterion for determining portions of multimedia to be printed. The motivation for doing so would have been to prevent taking every possible path through the application, saving time. Therefore it would have been obvious to combine the teachings of Wiernik with Parry for the benefits of allowing the generation of paper-based multimedia information using a selection criterion to prevent the printing of undesired or similar portions of multimedia.

Regarding Independent claim 6, Parry teaches *accessing printable representations for the first multimedia document and the second multimedia document* (paragraph 10, wherein a interface is provided to allow a user to select certain video frames to print from the video, therefore a frames representing a first and second document are accessed for printing); *Printing the consolidated printable representation on a paper medium to generate the paper document comprising one or more printed pages* paragraph 30, wherein video frames are printed once the user specifies the time or number of frames to print, therefore it is inherit that a paper medium with multimedia information is generated); *Generating a consolidated printable representation that includes the at least one portion for the second multimedia document that satisfy the selection criterion* (paragraph 7, wherein a method and apparatus are provided for printing digital video. The frames selected by the user are printed. The frame can also represent a second document. However Parry fails to explicitly teach a selection criterion used to determining the portions of multimedia to print); Wiernik teaches *analyzing the printable representation for the second multimedia document to identify at least one portion of the printable representation that satisfies the selection criterion*; *Analyzing the printable representation for the first multimedia document to identify at least one portion of the printable representation that satisfies the selection criterion* (paragraph 20 and 21, wherein each of the screens conform to the selection criterion and additional multi-media screens are created inheriting characteristics from the existing screens. Therefore the first and second documents information must satisfy the selection criterion); At the time of the

invention it would have been obvious to a person of ordinary skill in the art to include the use of a criterion for determining portions of multimedia to be printed. The motivation for doing so would have been to prevent taking every possible path through the application, saving time. Therefore it would have been obvious to combine the teachings of Wiernik with Parry for the benefits of allowing the generation of paper-based multimedia information using a selection criterion to prevent the printing of undesired or similar portions of multimedia.

Regarding Dependent claim 7, Parry teaches *generating the consolidated printable representation comprises including the at least one page from the printable representation for the first multimedia document and the at least one page from the printable representation for the second multimedia document in the consolidated printable representation* (paragraph 7, wherein a method and apparatus are provided for printing digital video. The frames selected by the user are printed. The frame can also represent a first and second document. However Parry fails to explicitly teach a selection criterion used to determining the portions of multimedia to print); Wiernik teaches *analyzing the printable representation for the first multimedia document comprises determining at least one page in the printable representation for the first multimedia document that comprises information that satisfies the selection criterion; Analyzing the printable representation for the second multimedia document comprises determining at least one page in the printable representation for the first multimedia document that comprises information that satisfies the selection criterion* (paragraph 20

and 21, wherein each of the screens conform to the selection criterion and additional multi-media screens are created inheriting characteristics from the existing screens.

Therefore the first and second documents information must satisfy the selection criterion); At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of a criterion for determining portions of multimedia to be printed. The motivation for doing so would have been to prevent taking every possible path through the application, saving time. Therefore it would have been obvious to combine the teachings of Wiernik with Parry for the benefits of allowing the generation of paper-based multimedia information using a selection criterion to prevent the printing of undesired or similar portions of multimedia.

Regarding Dependent claim 10, the claim contains the same limitation has claim 4 and is rejected under the same rationale.

Regarding Dependent claim 13, the claim is for a computer system performing the method of claim 1, and is similarly rejected under the same rationale.

Regarding Dependent claim 16, the claim is for a computer system performing the method of claim 4, and is similarly rejected under the same rationale.

Regarding Dependent claim 17, the claim is for a computer system performing the method of claim 5, and is similarly rejected under the same rationale.

Regarding Independent claim 18, the claim is for a computer system performing the method of claim 6, and is similarly rejected under the same rationale.

Regarding Dependent claim 19, the claim is for a computer system performing the method of claim 7, and is similarly rejected under the same rationale.

Regarding Dependent claim 22, the claim is for a computer system performing the method of claim 4, and is similarly rejected under the same rationale.

Regarding Independent claim 23, the claim is for a computer program product performing the method of claim 1, and is similarly rejected under the same rationale.

Regarding Dependent claim 25, the claim is for a computer program product performing the method of claim 5, and is similarly rejected under the same rationale.

Regarding Independent claim 26, the claim is for a computer program product performing the method of claim 6, and is similarly rejected under the same rationale.

Regarding Dependent claim 27, the claim is for a computer program product performing the method of claim 7, and is similarly rejected under the same rationale.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry (U.S. Pub 2002/0135808) in view of Wiernik (U.S. Pub 2001/0005203) further in view of Bozdagi (U.S. 6,647,535).

Regarding Independent claim 11, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of text information related to the multimedia frames. Bozdagi teaches *one or more pages, wherein at least one page of the one or more pages is imprinted with text information that is extracted from multimedia information stored by a plurality of multimedia documents if the text information satisfies a selection criterion, and wherein the at least one page is imprinted with one or more video frames corresponding to the text information extracted from the plurality of multimedia documents* (column 2, lines 4-15, wherein dynamic media which includes text information and video frames are converted to static images for printing). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the extraction of textual information from multimedia for printing. The motivation for doing so would have been to allow a more efficient handling of multimedia in a text format thereby avoiding extremely vague video content. Therefore it would have been obvious to combine the teachings of Bozdagi with Wiernik and Parry for the benefits of allowing a generation of paper-based multimedia representation from user criterion including textual information by avoiding vague video content.

Regarding Dependent claim 12, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of text information related to the multimedia frames that include closed-caption information. Bozdagi teaches *wherein the text information is extracted from closed-caption text information or audio information included in the multimedia information stored by the plurality of multimedia documents and the one or more video frames are extracted from video information in the multimedia information stored by the plurality of documents* (column 2, lines 4-15 & column 3, lines 30-45, wherein dynamic media which includes text information and video frames are converted to static images for printing. In addition audio and closed-caption information are transmitted as multimedia image data). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the extraction of textual information from multimedia including closed-caption and audio information. The motivation for doing so would have been to allow a more efficient handling of multimedia in a text format with audio and closed-caption data thereby avoiding extremely vague video content. Therefore it would have been obvious to combine the teachings of Bozdagi with Wiernik and Parry for the benefits of allowing a generation of paper-based multimedia representation from user criterion including textual information with audio and closed-caption data by avoiding vague video content.

7. Claims 2, 8, 14, 20, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry (U.S. Pub 2002/0135808) in view of Wiernik (U.S. Pub 2001/0005203) further in view of Bozdagi (U.S. 6,647,535) further in view of King (U.S. 5,600,775).

Regarding Dependent claim 2, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of text information related to the multimedia frames. Bozdagi teaches *printing text information on at least one page of the set of printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated* (column 2, lines 4-14, wherein multimedia text information is converted into static images and then printed. It is inherent that static images can comprise a set, thereby printing a set of documents representing the images. However Bozdagi fails to teach the annotation of the text information); King teaches the annotation of multimedia which includes text (column 2, lines 49-58). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation of text for printing multimedia information. The motivation for doing so would have been to allow the reduction of text information from multimedia, thereby saving time. Therefore it would have been obvious to combine the teachings of King with Bozdagi, Wiernik and Parry for the benefits of generating paper-based multimedia representation from a user criterion with annotated textual information saving paper cost and printing time.

Regarding Dependent claim 8, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of text information related to the multimedia frames. Bozdagi teaches *printing text information on at least one page of the one or more printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated* (column 2, lines 4-14, wherein multimedia text information is converted into static images and then printed. However Bozdagi fails to teach the annotation of the text information); King teaches the annotation of multimedia which includes text (column 2, lines 49-58). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation of text for printing multimedia information. The motivation for doing so would have been to allow the reduction of text information from multimedia, thereby saving time. Therefore it would have been obvious to combine the teachings of King with Bozdagi, Wiernik and Parry for the benefits of generating paper-based multimedia representation from a user criterion with annotated textual information saving paper cost and printing time.

Regarding Dependent claim 14, the claim is for a computer system performing the method of claim 2, and is similarly rejected under the same rationale.

Regarding Dependent claim 20, the claim is for a computer system performing the method of claim 8, and is similarly rejected under the same rationale.

Regarding Dependent claim 24, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of text information related to the multimedia frames. Bozdagi teaches *printing text information on at least one page of the set of printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated* (column 2, lines 4-14, wherein multimedia text information is converted into static images and then printed. It is inherent that static images can comprise a set, thereby printing a set of documents representing the images. However Bozdagi fails to teach the annotation of the text information); King teaches the annotation of multimedia which includes text (column 2, lines 49-58). In addition King discloses *code for printing one or more video frames on the at least one page such that at least one video frame that satisfies the selection criterion is annotated, wherein the one or more video frames are extracted from the portions of the multimedia information* (column 2, lines 1-15, wherein an indexing scheme relates the annotations to the video frames.). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation of text for printing multimedia information. The motivation for doing so would have been to allow the reduction of text information from multimedia, thereby saving time. Therefore it would have been obvious to combine the

teachings of King with Bozdagi, Wiernik and Parry for the benefits of generating paper-based multimedia representation from a user criterion with annotated textual information saving paper cost and printing time.

Regarding Dependent claim 28, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of text information related to the multimedia frames. Bozdagi teaches *printing text information on at least one page of the one or more printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated* (column 2, lines 4-14, wherein multimedia text information is converted into static images and then printed. However Bozdagi fails to teach the annotation of the text information); King teaches the annotation of multimedia which includes text (column 2, lines 49-58). In addition King discloses *code for printing one or more video frames on the at least one page of the one or more printed pages of paper document such that at least one video frame of the one or more video frames that satisfies the selection criterion is annotated* (column 2, lines 1-15, wherein an indexing scheme relates the annotations to the video frames.). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation of text for printing multimedia information. The motivation for doing so would have been to allow the reduction of text information from multimedia, thereby saving time. Therefore it would have been obvious to combine the teachings of King with

Bozdagi, Wiernik and Parry for the benefits of generating paper-based multimedia representation from a user criterion with annotated textual information saving paper cost and printing time.

8. Claims 3, 9, 15 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Parry (U.S. Pub 2002/0135808) in view of Wiernik (U.S. Pub 2001/0005203) further in view of King (U.S. 5,600,775).

Regarding Dependent claim 3, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of video frames from the selected criterion that is annotated. King teaches *printing one or more video frames on at least one page of the set of printed pages of the paper document such that at least one video frame that satisfies the selection criterion is annotated, wherein the one or more video frames are extracted from the portions of the multimedia information* (column 2, lines 1-15, wherein video frames are annotated and a indexing scheme relates the annotation to the video frames). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation of video frames. The motivation for doing so would have been to allow the reduction of picture information from multimedia, thereby saving time. Therefore it would have been obvious to combine the teachings of King with Wiernik and Parry for the benefits of generating paper-based multimedia

representation from a user criterion with annotated video information saving paper cost and printing time.

Regarding Dependent claim 9, Parry teaches the printing of video frames based on user selection (paragraph 7). Parry fails to teach the use of a selection criterion. Wiernik teaches the use of a selection criterion for creating a derived multimedia application (paragraph 19). Wiernik fails to teach the printing of video frames from the selected criterion that is annotated. King teaches *printing one or more video frames on at least one page of the one or more printed pages of the paper document such that at least one video frame of the one or more video frames that satisfies the selection criterion is annotated* (column 2, lines 1-15, wherein video frames are annotated and a indexing scheme relates the annotation to the video frames). At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation of video frames. The motivation for doing so would have been to allow the reduction of picture information from multimedia, thereby saving time. Therefore it would have been obvious to combine the teachings of King with Wiernik and Parry for the benefits of generating paper-based multimedia representation from a user criterion with annotated video information saving paper cost and printing time.

Regarding Dependent claim 15 the claim is for a computer system performing the method of claim 3 and is similarly rejected under the same rationale.

Regarding Dependent claim 21 the claim is for a computer system performing the method of claim 9 and is similarly rejected under the same rationale.

Other Prior Art Cited

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fukuda et al. (U.S. 5,898,166) discloses "Information Reproduction System Which Utilizes Physical Information On An Optically Readable Code And Which Optically Reads the Code To Reproduce Multimedia Information"
- Liu et al. (U.S. 6,865,714) discloses "Automatic Generation Of Card-Based Presentation Documents From Multimedia Data"
- Imade et al. (U.S. 5,898,709) discloses "Information Recording Medium And Information Reproducing Apparatus"
- Gupta et al. (U.S. 2002/0059342) discloses "Annotating Temporally-Dimensioned Multimedia Content"

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel

Patent Examiner

September 2, 2005


WILLIAM BASHORE
PRIMARY EXAMINER
9/2/2005